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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,862	07/03/2003	Leonard S. Schultz	14656	4394

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EXAMINER

GREENE, JASON M

ART UNIT PAPER NUMBER

1724

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/612,862

Applicant(s)

SCHULTZ, LEONARD S.

Examiner

Jason M. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/8/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 8 March 2006 has been entered.

### ***Allowable Subject Matter***

2. Applicant is advised that the Notice of Allowance mailed 13 December 2005 is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-5, 7 and 9-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trudel et al. (US 6,544,210 B1) in view of Wortrich et al. (US 6,592,543 B1).

With regard to claims 1, 9, 18 and 20, Trudel discloses a system for removing vapors and particulates from a pressurized surgical cavity (24) comprising a fluid pathway (18,20) including an intake end (18) and a return end (20), both ends being in fluid communication with the pressurized surgical site, a flow generating device (fan 54) in the fluid pathway between the intake end and the return end, and a particle removing filter (82,56) in the fluid pathway between the intake end and the flow generating device (see col. 6, lines 53-64), the filter comprising a filter media comprising a first (82) and a second (56) layer, wherein the first layer is immediately adjacent the second layer, wherein the flow generating device and the filter and generally immediately adjacent the surgical site when the system is in use and wherein the flow generating device generates a variable flow rate through the system for a fluid comprising insufflation in Figs.1-6 and col. 3, line 43 to col. 8, line 56.

Trudel et al. does not explicitly disclose the flow generating device creating a flow rate of 0.2 to 4.5 liters per minute.

Wortrich et al. discloses using a low flow rate of 1 to 6.5 liters per minute for insufflation to avoid dehydration and cooling of the patient in col. 9, lines 47-62.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the 1 liter per minute flow rate of Wortrich et al. into the system of Trudel et al. to avoid dehydration and cooling of the patient, as suggested by Wortrich et al. in col. 9, lines 47-62.

With regard to claims 2 and 19, using the low flow rate of Wortrich et al. in the system of Trudel et al. will inherently create a minimum total system pressure loss since pressure loss is proportional to flow rate.

With regard to claim 3, the claimed range of approximately 2.5 to approximately 4.0 liters per minute is seen as lying within the prior art range of 1 to 6.5 liters per minute. Therefore a prima facie case of obviousness exists which must be overcome through a showing of unexpected or unobvious results. See *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990) and MPEP 2144.05[R-1].

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With regard to claim 4, using the low flow rate of Wortrich et al. in the system of Trudel et al. will inherently create a minimum total system pressure loss since pressure loss is proportional to flow rate.

With regard to claims 5 and 15, Trudel et al. discloses the system, including the flow generating device, being disposable in col. 2, lines 53-65. The flow generating device is inherently sterile prior to use since it is designed for use in surgical procedures.

With regard to claim 7, Trudel et al. discloses the system further comprising a valve (46) adapted to control the fluid flow in Fig. 1 and col. 4, line 58 to col. 5, line 7

With regard to claims 10 and 16, Trudel discloses the flow generating device being battery powered and the system being operable without being coupled to any device remote from adjacent to the pressurized surgical site in col. 8, lines 20-36.

With regard to claims 11 and 17, Trudel discloses the flow generating device being a positive displacement pump (fan 54) generating a substantially steady air flow in col. 6, lines 30-52.

With regard to claims 12 and 13, the system of Trudel et al., including the flow generating device and filter, is inherently capable of undergoing sterilization since it is designed for use in surgical procedures.

With regard to claim 14, even though Trudel et al. does not explicitly teach the flow generating device being incapable of generating a spark, one of ordinary skill in the art at the time the invention was made would have recognized the need to design the flow generating device such that the flow generating device would be incapable of generating a spark (such as by containing all electrical connections within an air-tight chamber) since the system is intended for use in oxygen-rich environments such as operating rooms. The Examiner notes that the limitation "incapable of generating a spark" has been interpreted to mean that the flow generating device is designed such that it can not create a spark in the atmosphere where the system is being employed while the system is in operation. This interpretation is in view of Applicants' disclosure of the pump being flame proof in page 6, lines 1-3 of the instant specification.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trudel et al. (US 6,544,210 B1) and Wortrich et al. (US 6,592,543 B1) as applied to claim 1, and further in view of Schultz et al. (US 6,589,316 B1).

Trudel et al. and Wortrich et al. do not disclose the filter including a water trap.

Schultz et al. '316 discloses a similar system comprising a filter (16) including a water trap (55) in Fig. 12 and col. 4, line 60 to col. 5, line 31.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the water trap of Schultz et al. '316 into the filter of Trudel et al. to provide an area or region where water vapor contained in the gas can condense and settle without effecting the efficiency of the filter, as suggested by Schultz et al. '316 in col. 5, lines 6-10.

The applied Schultz et al. '316 reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).



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6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trudel et al. (US 6,544,210 B1) and Wortrich et al. (US 6,592,543 B1) as applied to claim 1, and further in view of Schultz et al. (US 6,110,259).

Trudel et al. and Wortrich et al. do not disclose the filter comprising an odor removing media.

Schultz et al. '259 discloses a similar system wherein the filter comprises an odor removing media (34) adapted to control the fluid flow in Fig. 3 and col. 4, lines 1-21.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the odor removal media of Schultz et al. '259 into the filter of Trudel et al. and Wortrich et al. to allow odorous gases to be removed from the gas flow, as is well known in the art.

### ***Conclusion***

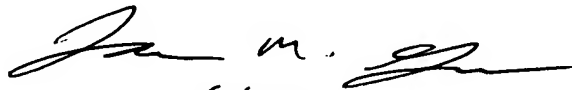
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Greene whose telephone number is (571) 272-1157. The examiner can normally be reached on Monday - Friday (9:00 AM to 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason M. Greene  
Primary Examiner  
Art Unit 1724

  
6/9/06

jmg  
June 9, 2006